

Appeal No. 95-0277  
Application 08/002,563

***THIS OPINION WAS NOT WRITTEN FOR PUBLICATION***

The opinion in support of the decision being entered today  
(1) was not written for publication in a law journal and  
(2) is not binding precedent of the Board.

Paper No. 10

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* JOHN R. SANDERSON  
and JOHN F. KNIFTON

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Appeal No. 95-0277  
Application 08/002,563<sup>1</sup>

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On BRIEF

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Before GARRIS, PAK and WARREN, *Administrative Patent Judges*.

WARREN, *Administrative Patent Judge*.

*Decision on Appeal*

This is an appeal under 35 U.S.C. ' 134 from the decision of  
the examiner finally rejecting claims 6, 7 and 9. Claim 9 was

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<sup>1</sup> Application for patent filed January 11, 1993. According to  
appellants, this application is a continuation-in-part of  
application for patent 07/833,200, filed February 10, 1992, now  
abandoned.

subsequently canceled by appellants, leaving only claims 6 and 7 for consideration on appeal.

The appealed claims as represented by claim 6 are drawn to the treatment of a methyl tertiary butyl ether (MTBE) recycle stream containing, *inter alia*, 40 to about 60 wt.% of methanol, tertiary butyl alcohol, MTBE and the peroxides tertiary butyl hydroperoxide and ditertiary butyl peroxide, by contacting the same with a silica-supported catalyst as specified in claim 6 at about 160E to about 180EC in order to catalytically decompose said peroxides and to form additional MTBE.

The reference relied on by the examiner is:

Sanderson et al. (Sanderson)	4,704,482	Nov. 3,
1987		

The examiner has rejected claims 6 and 7 on appeal under 35 U.S.C. ' 103 as being unpatentable over Sanderson. We reverse.

Rather than reiterate the respective positions advanced by the examiner and appellants, we refer to the examiner's answer and to appellants' brief for a complete exposition thereof.

#### *Opinion*

We have carefully reviewed the record on this appeal and based thereon conclude that the examiner has not established that one of ordinary skill in this art would have been motivated by the teaching of Sanderson to utilize the catalysts disclosed therein to decompose peroxides in an MTBE recycle stream which contains MTBE and 40 to about 60 wt.% of methanol at about 160E to about 180EC with the reasonable expectation of forming MTBE in addition to catalytically decomposing peroxides. Indeed, as a matter of

elementary claim construction, appealed claim 6 clearly requires the formation of "additional" MTBE. The examiner has steadfastly refused to consider this matter even though appellants have pointed to this claim limitation and argued that the formation of MTBE was an unexpected result. Accordingly, in the absence of evidence and/or scientific reasoning establishing that one of ordinary skill in this art would have reasonably expected the formation of additional MTBE under the reaction conditions specified in appealed claim 6, we are left with the inference that Sanderson would not have suggested the claimed invention as a whole to one of ordinary skill in this art in the absence of appellants' specification.

The examiner's decision is reversed.

*Reversed*

BRADLEY R. GARRIS	)	
Administrative Patent Judge	)	
	)	
	)	
	)	
CHUNG K. PAK	)	BOARD OF PATENT
Administrative Patent Judge	)	APPEALS AND
	)	INTERFERENCES
	)	
	)	

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CHARLES F. WARREN                    )  
Administrative Patent Judge        )

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